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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,834	01/15/2002	Tara Chand Singhal	11195-37	5902

7590 12/01/2006
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EXAMINER

OYEBISI, OJO O

ART UNIT	PAPER NUMBER
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3692

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/046,834

Applicant(s)

SINGHAL, TARA CHAND

Examiner

OJO O. OYEBISI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29, 32-37 and 41-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29, 32-37 and 41-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 09/19/06.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Applicant's election without traverse of Group I (claims 1-29, 32-37, 41-50) in the reply filed on 09/19/06 is acknowledged.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-5, 12, 13, 14, 9-11, 15, 32-33, 41-44, and 48-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Treyz et al (US PAT: 6,587,835).

Re claims 1-5, 12, 13, 14. Treyz discloses a payment system between a customer and a merchant comprising: a central system; a portable wireless device; a merchant display terminal; and a terminal identification tag with a display terminal identification; the central system, the portable wireless device and the merchant terminal on a global computer network; wherein the portable wireless device is used to effect a private and secure payment transaction (see col.17 line 60-col.18 line 45, see fig.10 and fig.14).

Re claim 9. Treyz further discloses, wherein the wireless device identification is a combination of a pre-programmed identification code and a customer entered card personal identification number (CPIN) (see col.18 lines 40-45).

Re claims 10, 11. Treyz further discloses, wherein the customer having a plurality of

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pre-stored account data in the central system, the customer entering the CPIN into the wireless device, identifying a specific account data to be used for a payment transaction (see fig.57, also see col.40 line 65-col.41 line 10, see col.17 line 60-col.18 line 15).

Re claim 15. Treyz further discloses, wherein, the central system maintaining a transaction database cataloging each payment transaction by a transaction reference, date, time, an authorization reference, payment amount, customer identification and merchant identification (i.e., financial transaction records, see col.66 lines 8-36).

Re claims 32, 33. Treyz further discloses a payment system between a customer and a merchant comprising: a central system; a portable wireless device; a payment card with an encrypted card number; a standard bankcard; a merchant card reader (see fig.107 element 1016) and a merchant display terminal with an identification tag (see fig.107 element 1004); the central system, the portable wireless device, the merchant wireless card, reader and the display terminal are on a global computer network (see fig.2 and fig.107); wherein, at least one of the group including the portable wireless device, the payment card, and the bankcard, is selected by the customer to effect a payment transaction (see col.17 line 60-col.18 line 45, see fig.57, also see col.40 line 65-col.41 line 10).

Re claim 41. Treyz further discloses a payment system between two parties comprising: a central system; a portable wireless device belonging to party A; the central system and the portable wireless device are on a global computer network; wherein the portable wireless device is used to effect a private and secure payment

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transaction to a party B (see col.17 line 60-col.18 line 45, see fig.10 and fig.14).

Re claims 42, 43, 44. Treyz further discloses, wherein at time of payment transaction from party A to party B, a party B identification and a payment amount is entered into the wireless device (see fig.57, see fig.6 element 134, also see col.40 line 65-col.41 line 10, see col.17 line 60-col.18 line 15).

Re claim 48. Treyz further discloses, wherein the wireless device identification is a combination of a pre-programmed identification code and a customer entered personal identification code (see col.18 lines 40-45).

Re claims 49. Treyz further discloses, wherein the wireless device is a personal digital assistant adapted with a wireless modem (see col.2 lines 10-15).

Re claim 50. Treyz further discloses, wherein the device is a cellular telephone (see col.13 lines 39-46).

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims **21-23, and 25-29** are rejected under 35 U.S.C. 102(b) as being anticipated by Lawlor et al (US PAT: 5,220,501).

Re claim 21. Lawlor further discloses a payment system between a customer and a merchant comprising: a central system; a payment card with an encrypted card number; a merchant card reader and a merchant display terminal; wherein the central system, the card reader, and the display terminal are on a global computer network and wherein

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the payment card is used to effect a private and secure payment transaction (see fig. 1 and fig. 1a, also see col. 27 lines 5-56).

Re claim 22. Lawlor further discloses, wherein the payment card is swiped in the card reader and a card personal identification number (CPIN) is entered by the customer, the merchant terminal identification and a payment amount is entered into it by the merchant, and a data record including at-least the foregoing data and the encrypted card number is sent by the card reader over the global network to the central system (see col. 27 lines 5-56, also see col. 28 lines 1-50).

Re claim 23. Lawlor further discloses, wherein the central system decrypts the payment card number and the CPIN to identify customer pre-stored bank card data and assembles a payment transaction record using bankcard data, submits the payment transaction record to an automated clearing house (ACH) and receives payment authorization record (see col. 20 lines 16-25, also see col. 27 lines 15-35).

Re claims 25, 26. Lawlor further discloses, the payment transaction record submitted to the ACH identifies a central system business bank for receiving payment amount from the ACH (see col. 33 lines 50-67, also see col. 34 lines 5-65).

Re claims 27, 28. Lawlor further discloses, wherein the encrypted card number embeds a decryption algorithm reference, enabling the central system using a decryption algorithm from a plurality of pre-stored algorithms to decipher the customer identification number (see col. 20 lines 16-25, also see col. 27 lines 15-35).

Re claim 29. Lawlor further discloses, wherein the customer having a plurality of pre-stored accounts in the central system (see col. 53 lines 25-50), the customer entering

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the CPIN into the card reader, wherein the CPIN is a combination of personal identification code verifying the customer and an account identification code (see col.27 lines 5-56, also see col.28 lines 1-50).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 6-7, 8, 34, 36-37, 45-46, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz in view of Lawlor.

Re claims 6-7, 8, 34, 36-37, 45-46. Treyz does not disclose, wherein the central system assembles a payment transaction record, including customer pre-stored bank account data, and submits the payment transaction record to an automated clearing house (ACH), and receives a payment authorization record and subsequently the central system sends the payment authorization record to the merchant display terminal using the terminal identification as a uniform resource locator over the global computer

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network. However, Lawlor makes this disclosure (i.e., After payment authorization is received from the bank (through the ATM interchange), the bill payment enters the central processor 52 from the terminal, and a series of log and transaction files are updated by the POS and bill payer modules. The payee/vendor information file is accessed to determine his status, electronic or paper payment, the appropriate address is obtained from the address verification file and particular payment information is obtained from the payments descriptor file. If the payment is scheduled for today, it is routed to the appropriate exchange (ACH) or routed to other direct electronic transmitted or remittance tape for delivery to the payee.

Provisions are also made to aggregate and time payments (from multiple terminal users) to a single payee. If the payment cannot be made by electronic means, a paper check must be cut and mailed. In cases where multiple payments can be made to a single payee, a (single) "check and list" (of payor information) is forwarded. A reference number is created for each electronic or paper payment (this reference number is used for terminal user and payee servicing, see col.33 lines 50-67, see col.34 lines 5-65, also see col.53 lines 1-50). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Treyz and Lawlor for immediate settlement of financial transactions that transpire between the payor and the merchant.

Re claim 47. Treyz further discloses, the central system, having a database with party A's e-mail address and party B's e-mail addresses, sends a notification of the payment

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authorization to the party A and party B's e-mail addresses (see fig.49 element 564).

7. **Claims 24, 35** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawlor in view of Treyz..

Re claims 24, 35. Lawlor does not explicitly disclose, the central system having a database having data on the terminal identification and the display terminal uniform resource locator, sends payment authorization record to the merchant display terminal using the uniform resource locator over the global computer network. However, Treyz makes this disclosure (see fig.37 element 440, also col.337 line 50-col.38 line 65). Thus it would have been obvious to one of ordinary skill in the art to combine Lawlor and Treyz for immediate settlement of financial transactions that transpire between the payor and the merchant.

8. **Claims 16-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz in view of Foth (US PAT: 6,941,286).

Re claims 16-20. Treyz does not explicitly disclose, further comprising a merchant refund terminal on the global computer network, wherein the merchant entering into the refund terminal a refund record, including at-least the payment transaction reference from a previous payment transaction, the merchant identification, a refund authorizing password, a refund amount, and sending the refund record to the central system. However, Foth discloses further comprising a merchant refund terminal (i.e., post office) on the global computer network (see fig.1), wherein the merchant entering into the refund terminal a refund record, including at-least the payment transaction reference

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from a previous payment transaction, the merchant identification, a refund authorizing password, a refund amount, and sending the refund record to the central system. (see fig.3, also see col.4 line 22-col.5 line 50, also see the summary of the invention). Thus it would have been obvious to one of ordinary skill in the art to combine Treyz and Foth in order to facilitate a refund for a disputed transaction between trading parties.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD E. CHILCOT can be reached on (571)272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


FRANTZY POINVIL
PRIMARY EXAMINER

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